

Appln No. 10/646,064

Amdt date October 28, 2004

Reply to Office action of May 28, 2004

REMARKS

Applicants respond to each point raised by the Examiner in the May 28, 2004 Office action as follows:

Priority

On June 8, 2004, after the mailing date of the present Office action, Applicants submitted certified copies of the foreign priority applications as required by 35 U.S.C. § 119(b).

Drawings

Applicants are submitting herewith corrected drawings that designate Figures 1-8 as being "Prior Art" and, therefore, the objection to the drawings is obviated.

The drawings were also objected to as allegedly not showing the features recited in claims 7-8. Applicants respectfully traverse this objection and note that the features of claims 7-8 are depicted in Figures 4 and 5. Moreover, although these figures are depicted as "prior art," Applicants' Specification explains that the features shown in Figures 1-8 can be incorporated within Applicants' shoulder joint prosthesis and, accordingly, those features are considered as disclosed as potentially being used with Applicants' invention. (See Specification at pg. 7, line 27 to pg. 8, line 2). Therefore, the features of claims 7-8 are shown in Applicants' drawings, and the objection is overcome.

Claim Rejections Under 35 U.S.C. § 112

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Amendments to the Drawings

The attached two sheets of drawings labeled sheets 1 and 2, reflect amendments to Figures 1-8 and replace the originally filed sheets 1 and 2.

Attachment: Replacement Sheets
 Annotated Sheet Showing Changes

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Claims 7-8, 12, and 16 have been rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. As reflected above, claim 12 has been cancelled, thereby obviating the rejection.

Concerning claims 7-8, Applicants respectfully submit that the claimed subject matter is clearly shown in Figures 4 and 5. As explained above with respect to the objection to the drawings, those features are considered as disclosed as potentially being used with Applicants' invention. (See Specification at pg. 7, line 27 to pg. 8, line 2). Therefore, Applicants respectfully request the rejection of claims 7-8 under § 112 be withdrawn. Moreover, those claims have been amended to depend from an allowable base claim.

With respect to claim 16, Applicants have rewritten dependent claims 19 and 21 in independent form, which has incorporated the subject matter of claim 16 into those claims and all claims depending therefrom.

To overcome the alleged indefiniteness and ambiguity of the phrase "in particular of basket-like or quiver-like shape," in claim 16, Applicants have amended the phrase to state "having a basket-like or quiver-like shape" in claims 19 and 21. This amendment has not narrowed the claim and was not made for purposes of overcoming prior art, but rather to more clearly recite the structure of the original claim. Further, as this limitation is explained in the Specification, the terms "basket-like" and "quiver-like" are used interchangeably to give a relative description of the shape and, therefore, are not used

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ambiguously in the claims. (See Specification at pg. 13, lines 23-25.)

Therefore, pending claims 2-8, 14, and 17-21 satisfy 35 U.S.C. § 112, second paragraph. Although Applicants are not addressing herein the obviated rejections under § 112, second paragraph, they reserve the right to do so in a later continuation application.

Claim Rejections Under 35 U.S.C. § 102 and § 103

Claims 1-5, 9-14 and 16-18 have been rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Tornier (5,358,526). Claims 6 and 8 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tornier in view of the prior art shown in Applicants' Figures 1-8.

As reflected above, Applicants have cancelled claims 1 and 9-13, thereby obviating rejection of these claims. Nonetheless, Applicants respectfully disagree with these rejections and reserve the right to address these issues in a continuation application. With respect to the other rejected claims, they all now depend from an allowable base claim, namely claim 19, and are therefore allowable as well. Accordingly, Applicants have obviated each of the claim rejections under § 102 and § 103.

Allowable Subject Matter

The Examiner indicated that claim 15 would be allowable if rewritten in independent form including all of the limitations of the base claim. As reflected above, Applicants have

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rewritten claim 15 in independent form including all of the limitations of the base claim.

The Examiner also indicated that claims "19-16" would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph, and to include all of the limitations of the base claim and any intervening claims. Applicants believe that the reference to claims "19-16" was a typographical error and, based on the Examiner's other statements in the Office action and the subject matter of the claims at issue, that the Examiner intended to state that claims 19-21 would be allowable. Accordingly, Applicants have rewritten claims 19 and 21 in independent form including all of the limitations of the base claim and the intervening claim, and claim 20 remains dependent from claim 19. The other pending claims, namely claims 2-8, 14, and 17-18, either directly or indirectly depend from claim 19 and, therefore, are also allowable for at least that reason.

Therefore, pending claims 2-8, 15, and 17-21 are in condition for allowance.

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CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that pending claims 2-8, 14-15, and 17-21 are in condition for allowance and, accordingly, a timely indication thereof is respectfully requested.

Respectfully submitted,
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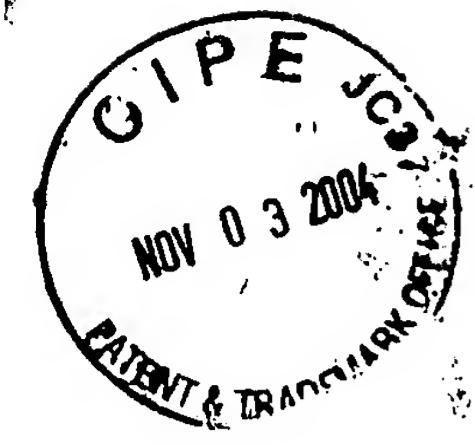


FIG. 2
PRIOR ART

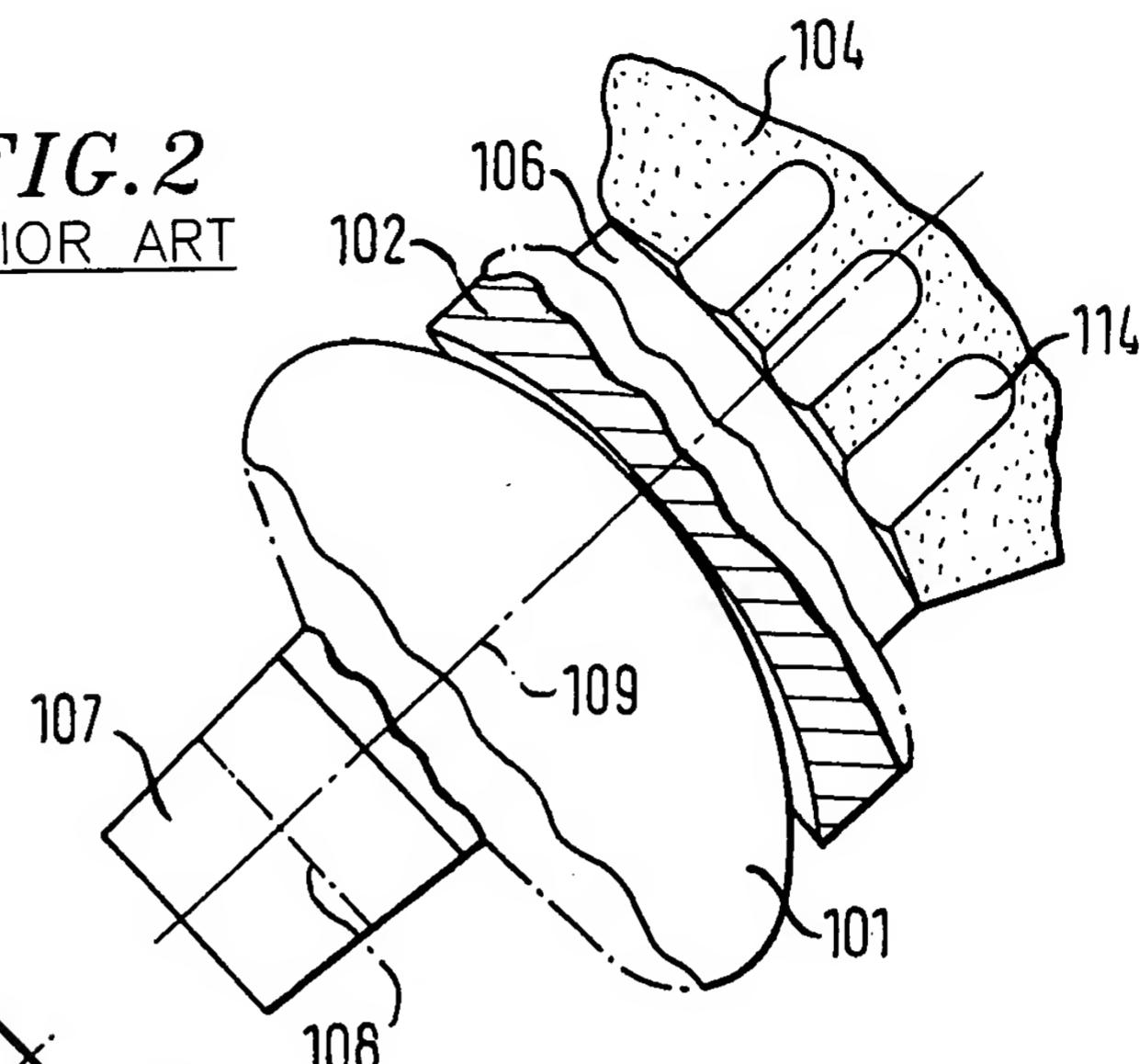


FIG. 1
PRIOR ART

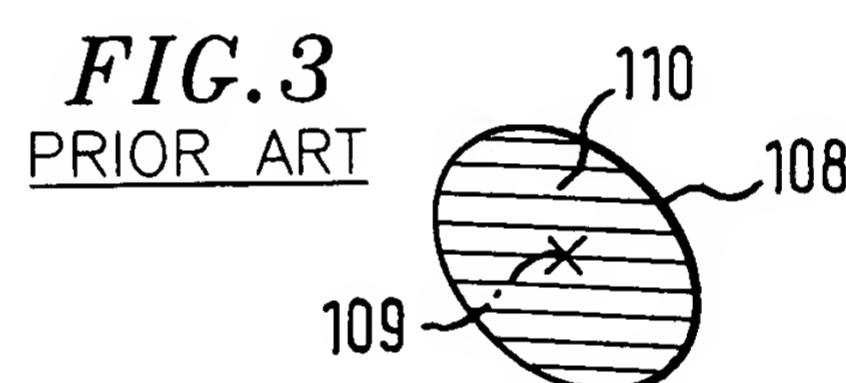
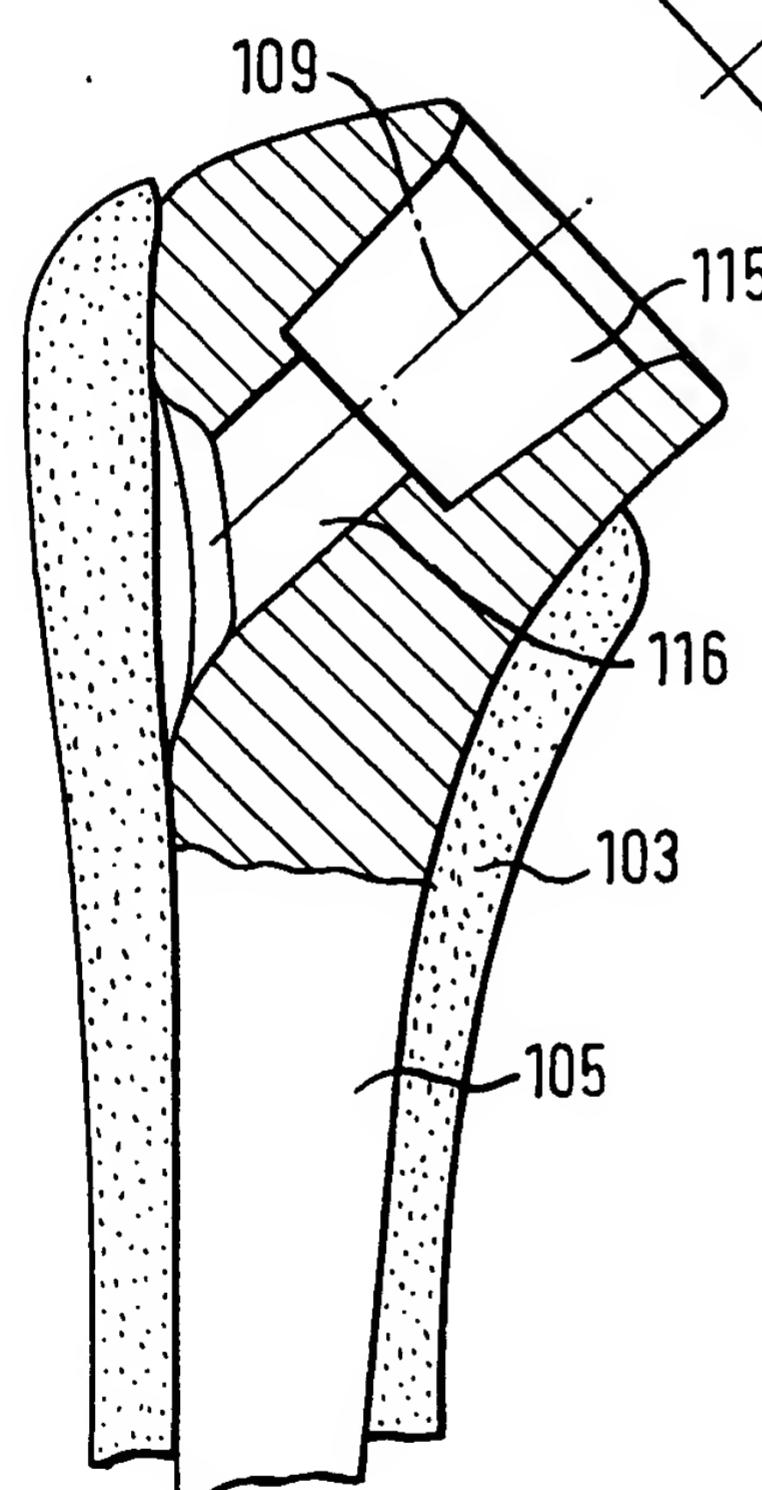


FIG. 4
PRIOR ART

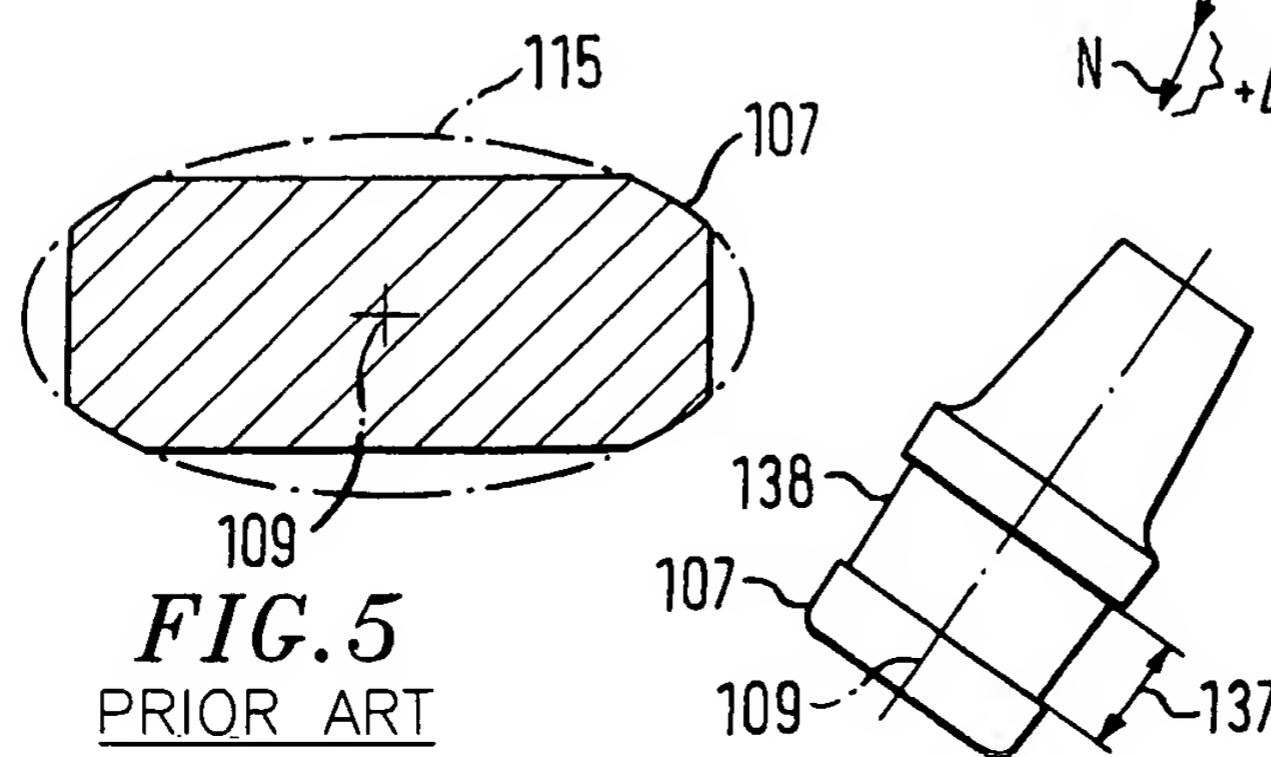
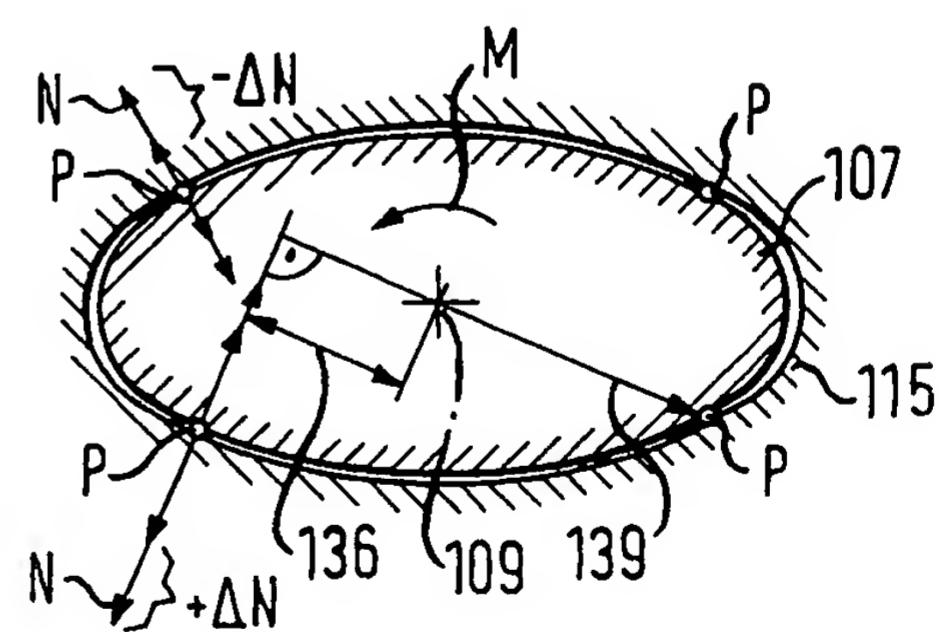


FIG. 6
PRIOR ART

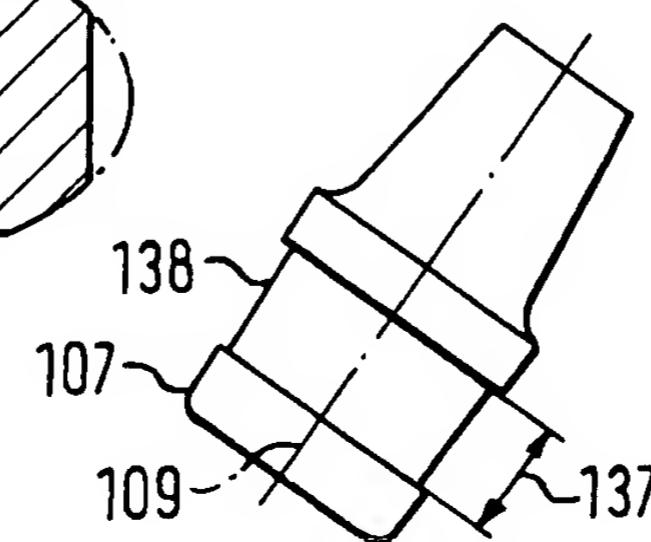


FIG. 7
PRIOR ART

